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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,530	08/15/2002	Bernd Bruchmann	220258USOPCT	9251
22850	7590	10/10/2003		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER GORR, RACHEL F	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 10/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,530

Applicant(s)

BRUCHMANN ET AL.

Examiner

Rachel F. Gorr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 0815. 6) ☐ Other: ____.

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1. In the list of amended claims, claim 16 has been omitted. The list of claims should indicate that claim 16 has been cancelled.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 8-12, 14-19, 21-23 and 26-31 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bayards (WO99/14254).

Bayards discloses, in experiment 3, a solid, unsaturated urethane that melts at 80 deg. C. He makes the urethane from a linear aliphatic diisocyanate, an aliphatic polyester diol, and an olefinically unsaturated compound containing an isocyanate-reactive functional group. On page 8, he teaches reacting one mole of diisocyanate and one mole of unsaturated compound, and then reacting the product with the diol. In example II, he uses the urethane to make a powder coating. When a reference discloses all the limitations of a claim except a property (breadth of the melting range, and glass transition temperatures), and the examiner can't determine if the reference inherently anticipates the claimed invention, the burden of showing

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difference is shifted to the applicant as in *In re Fitzgerald* (205 USPQ 594). See MPEP 2112.

5. Claims 7, 13, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayards in view of Hall.

6. Bayards discloses the invention of the claims (see above rejection) but differs from these claims by not disclosing hydroxy (meth)acrylates as the olefinically unsaturated compound for forming the urethane, and by not disclosing the method of preparation by reacting the diisocyanate with the compound containing at least two isocyanate-reactive groups before reacting with the olefinically unsaturated compound.

7. Hall discloses urethane made from hexamethylene diisocyanate (top col. 4), a glycol and an olefinically-unsaturated compound comprising hydroxy (meth)acrylates (see examples). He uses his urethane for powder coatings (see examples). In example 1 and example 2, he shows both methods of preparation as applicant's claims 12 and 13.

8. It would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare Bayards urethane by first reacting the diisocyanate and polyol because Hall shows that unsaturated urethane powders can be made equally well by either method – first reacting the diisocyanate and polyol or first reacting the diisocyanate and the unsaturated monomer. It would have been obvious to use acrylate monomers because Hall shows that these can be used to make unsaturated urethanes for powder coatings.

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9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bayards in view of Sacharski.

10. Bayards discloses the invention of the claims (see above). He differs from this claim by not showing making a powder slurry coating.

11. Sacharski discloses that powder suluuries can be made from acrylic and polyurethane power coatings (top col. 3).

12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the powder of Bayards into a slurry because Sacharski teaches that this is a way to avoid dusting problems (col. 1, lines 25-30).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel F. Gorr whose telephone number is 703-308-3608. The examiner can normally be reached on Mon., Tues., Thurs., Fri., from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 703-308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

R.G.


RACHEL GORR
PRIMARY EXAMINER